

REMARKS

Claims 33, 35, and 37-46 are all the claims presently pending in the application. Claim 38 is amended for clarification purposes. Claims 45 and 46 are added to claim additional features. No new matter is added.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 33, 25, 37-39, and 41-44 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kim et al. (U.S. Patent Publication No. 2003/0012558 A1) in view of Taira et al. (U.S. Patent No. 6,009,234). Claim 40 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kim in view of Taira, and further in view of Abecassis (U.S. Patent No. 6,289,165 B1).

These rejections are respectfully traversed in the following discussion.

I. THE PRIOR ART REJECTIONS

A. The Alleged Kim and Taira Combination

Kim discloses an information storage medium containing multi-language markup document information, and an apparatus for and a method of reproducing the information storage medium. (Kim at Abstract). Taira discloses a recording apparatus for recording information in the large-capacity recording medium. (Taira at Abstract). The Office alleges that the combination of Kim and Taira makes the claims obvious.

However, Applicants respectfully disagree and submit that the Office fails to meet the initial burden of establishing obviousness. As a result, a *prima facie* case of obviousness is not established. Thus, since the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness, the burden to establish patentability is not shifted to Applicants.

Specifically, MPEP § 2142 provides

[t]he legal concept of *prima facie* obviousness is a procedural tool of examination
It allocates who has the burden of going forward with production of evidence
The examiner bears the initial burden of factually supporting any *prima facie*

conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness

(emphasis added).

The Office alleges that paragraph [0047] of Kim teaches “a plurality of interactive graphics streams corresponding to the audio-visual data stream, which are used to control reproduction of the audio-visual data stream” (Office Action at page 3, fourth paragraph). Paragraph [0047] of Kim specifically states that

[t]he DVD **300** contains multiple markup documents having the same meaning of the content in different languages so that the text information included in the markup documents can be displayed in multiple languages. That is, the DVD **300** include the multiple markup documents which contain exactly the same meaning text information in respective multiple languages.

However, the Office fails to interpret the “multiple markup documents” of Kim as would one having ordinary skill in the art. Simply put, Kim fails in its entirety to teach or suggest anything remotely resembling “a plurality of interactive graphics streams”. Indeed, one of ordinary skill in the art would clearly find that the “multiple markup documents” of Kim completely fail to teach or suggest anything remotely resembling “a plurality of interactive graphics streams”.

In its entirety, Kim clearly fails to teach or suggest “a plurality of interactive graphics streams” *per se*. Therefore, it becomes the Office’s burden to produce evidence and factually support that the cited portion of Kim teaches or suggests “a plurality of interactive graphics streams”. The Office clearly fails to meet this burden. Indeed, the Office has asserted nothing that would lead one having ordinary skill in the art to believe that Kim teaches or “a plurality of interactive graphics streams”.

The Office admits that deficiencies are present in Kim. (Office Action at page 4, third full paragraph). To make up for those admitted deficiencies, the Office applies Taira. The Office alleges, at page 4, third paragraph of the present Office Action, that

Taira teaches a method of reproducing information in which a language code is stored in the player apparatus and is used to select a data stream (see Taira column 43 lines 51-56, “*the language previously held in the apparatus, or the player, is referred to and an audio stream and a video stream are set*”).

However, there is another portion of Taira that more particularly defines where “the language previously held in the apparatus” is stored. Indeed, column 39, line 67 to column 40, line 5 of Taira states that “the parameters necessary for playback of the video manager menu are set in the video

decoder section 58, audio decoder section 60, and sub-picture decoder section 62 . . .” This passage of Taira serves to contradict the Office’s allegation.

Further, Applicants respectfully submit that the Office fails to interpret Taira as would one having ordinary skill in the art. Specifically, there is absolutely no teaching or suggestion of “attribute information stored in a player status register in the reproducing apparatus” by Taira. Moreover, there is absolutely no teaching or suggestion of “a player status register” by Taira.

For all of the above-referenced reasons, the Office fails to meet the initial burden of establishing obviousness. As a result, a prima facie case of obviousness is not established. Thus, since the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness, the burden to establish patentability is not shifted to Applicants.

Therefore, Applicants respectfully request the Office to reconsider and withdraw this rejection.

B. The Abecassis Reference

To make up for the admitted deficiencies of the alleged Kim and Taira combination, the Office applies Abecassis. Abecassis discloses a method of and a system capable for playing a presentation segment from a set of interleaved presentation segments including within a video. (Abecassis at Abstract). The Office alleges that the combination of Kim, Taira, and Abecassis makes the claims obvious.

However, the Office fails to produce evidence and factually support that Abecassis makes up for any of the above-referenced deficiencies with respect to the alleged Kim and Taira combination.

Further, the Office erroneously alleges that column 1, lines 18-36 of Abecassis “teaches viewer class information, . . . sub-title language information, . . . and audio language information.” (Office Action at page 10, second paragraph). This allegation was previously made by the Office in the Final Office Action dated October 29, 2008. In fact, the passage in which this allegation is stated in the present Office Action is largely identical to the passage in which this allegation was made in the Final Office Action dated October 29, 2008. Further, the Office admitted that the Abecassis failed to teach or suggest this information during the Personal Interview conducted on April 21, 2009. (See Interview Summary, April 21, 2009).

Since the Office has seemingly reclaimed this allegation regarding Abecassis, Applicants reassert the successful traversal of this allegation made on page 16 of the Amendment Accompanying Request for Continued Examination dated February 17, 2009 as follows:

The Examiner considers column 1, lines 18-36, of Abecassis to disclose “viewer class information, sub-title information, and audio language information” as recited in claim 40. The Examiner states that these pieces of information are “attributes typically stored on DVD discs.” However, claim 40 recites that these pieces of information are “attribute information” that is “obtain[ed] from a player status register in the apparatus” as recited in claim 35 from which claim 40 depends. The Examiner has not explained how the “viewer class information, sub-title language information, and audio language information” allegedly disclosed in column 1, lines 18-36, that the Examiner considers to be “attributes typically stored on DVD discs” can be considered to be “attribute information” as recited in claim 40 that is “obtain[ed] from a player status register in the apparatus” as recited in claim 35 from which claim 40 depends, such that the Examiner has not established a *prima facie* case of obviousness with respect to claim 40.

In view of the above, Applicants respectfully submit that the Office fails in its second attempt to interpret Abecassis as would one having ordinary skill in the art. Thus, even in spite of the attempt to modify the alleged Kim and Taira combination through the application of Abecassis, the Office fails to meet the initial burden of establishing obviousness. As a result, a *prima facie* case of obviousness is not established. Thus, since the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness, the burden to establish patentability is not shifted to Applicants.

Therefore, Applicants respectfully request the Office to reconsider and withdraw this rejection.

II. NEW CLAIMS

New claims 45 and 46 are added to claim additional features and to provide more varied protection. These claims are independently patentable because of the novel and nonobvious features recited therein.

Applicants submit that the new claims are patentable at least for analogous reasons to those set forth above.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 33, 35, and 37-46, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Office is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Office find the application to be other than in condition for allowance, the Office is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Respectfully Submitted,



Date: September 9, 2010
North Star Intellectual Property Law, PC
1156 15th Street, NW, Suite 603
Washington, DC 20005
(202) 429-0020
Customer No. 89980

Christopher R. Monday
Registration No. 60,929